

REMARKS

The Office Action dated March 10, 2005, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto. Claims 1 and 2 are pending and respectfully submitted for consideration.

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sexton (U.S. Patent No. 3,877,885). Sexton was cited for disclosing many of the claimed elements of the invention with the exception of copper cladding with an areal ratio of 25-40%, as recited in claims 1 and 2. The Office Action took the position that Sexton teaches that the sizes or the thickness of the copper-cladding material could be selected relative to the total volume of the wire. The Applicants traverse the rejection and respectfully submit that Sexton does not disclose or suggest the claimed features of the invention.

As noted above, claims 1 and 2 recite "a conductor wire including . . . copper cladding . . . with an areal ratio of 25-40%." In contrast, Sexton discloses cladding formed in a composite wire comprises either 10 or 15 percent of the total volume of the composite wire. See column 3, lines 32-35 of the Sexton. Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that the prior art could be so modified would not have made the modification obvious *unless the prior art suggested the desirability of the modification*. (Emphasis added). In re Gordon, 733 F.2d 900, 902, 221 USPQ

1125, 1127 (Fed. Cir. 1984). The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to modify the relevant teachings of the applied prior art to arrive at the claimed invention. See Ex Parte Horvat 1996 WL 1748584 (Bd.Pat.App & Interf.) (citing In re Fine at 1074, 5 USPQ2d at 598 (Fed. Cir. 1988)).

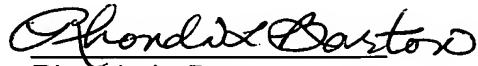
In this case, Sexton does not suggest the desirability of modifying the cladding from 10 or 15 % to 25-40%. As such the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 1 and 2 under 35 U.S.C. §103. Accordingly, the Applicants respectfully request withdrawal of the rejection, allowance of claims 1 and 2, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper,

may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107156-00233.**

Respectfully submitted,



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